

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY S. WALKER, MAGDALENA MIK, MICHIKO KOBAYASHI
GEOFFREY M. GELMAN, RUSSELL PRAT SAMMON and
ANDREW P. GOLDEN

Appeal No. 2006-3177
Application No. 09/609,017
Technology Center 3600

HEARD: November 16, 2006

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before OWENS, LEVY and FETTING, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal is from a rejection of claims 3-14, 26-29 and 34-51, which are all of the pending claims.

THE INVENTION

The appellants claim a method, apparatus and computer program for increasing and/or monitoring a party's compliance with a schedule for taking medicines. Claim 3 is illustrative:

A method comprising:

receiving a signal; and

determining whether a first container for storing a first medicine was positioned so as to wirelessly communicate with a second container for storing a second medicine based at least in part on the signal.

THE REFERENCES

Bro	5,722,418	Mar. 3, 1998
Andrews	5,757,271	May 26, 1998
Reber et al. (Reber)	5,950,632	Sep. 14, 1999
Brown	6,151,586	Nov. 21, 2000
	(effective filing date on or before	Nov. 21, 1997)
Daansen et al. (Daansen)	6,375,038	Apr. 23, 2002
		(filed Jun. 12, 2000)

THE REJECTIONS

The claims stand rejected as follows: claims 3-14, 34, 35 and 39-51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention; claims 3-14, 34, 35 and 39-51 under 35 U.S.C. § 101 as failing to recite a limitation in the technological arts; claims 3-14, 26, 27 and 39-42 under 35 U.S.C. § 103 as obvious over Reber in view of Andrews; claims 28, 29, 34-38, 43, 44, 46-48 and 51 under 35 U.S.C. § 103 as obvious over Reber in view of Andrews and Brown; claim 45 under 35 U.S.C. § 103 as obvious over Reber in view of Andrews, Brown and Bro; and claims 49 and 50 under 35 U.S.C. § 103 as obvious over Reber in view of Andrews, Brown and Daansen.¹

¹ The rejection under 35 U.S.C. § 112, second paragraph, is withdrawn as to claims 26-29, 36 and 37 in the examiner's answer (page 33).

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of the appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues, regarding claims 3-14,² that "receiving a signal" is not descriptive because it is not clear whether "signal" encompasses sound, color, physical action, voltage, current, or a combination thereof, and that "determining" is indefinite because it is not clear what steps the determining includes (answer, page 4). The examiner has not established that "signal" and "determining", when given their broadest reasonable interpretation in view of the appellants' specification, are to be interpreted as limited to anything less than any type of signal and any determining steps. The terms "signal" and

² We consider this argument to also apply to claims 39-50 that have the limitations argued with respect to claims 3-14 and are not addressed by the examiner.

"determining" are broad, but that breadth does not necessarily render the claims indefinite. *See In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) ("Breadth is not indefiniteness."); *In re Borkowski*, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970).

The examiner argues that "a first container for storing a first medicine" and "a second container for storing a second medicine" are confusing because those terms are structural elements and are not defined prior to the method step (answer, page 4). The examiner has not explained why those elements need to be defined prior to the determining step for the scope of the claims to have been reasonably clear to one of ordinary skill in the art. The determining step of claim 3, to which the examiner's argument is directed, does not recite "the first container" or "the second container" but, rather, recites "a first container" and "a second container", and the meanings of "a first container for storing a first medicine" and "a second container for storing a second medicine" are clear on their face.

The examiner argues that in claim 34, "determining a level to which the party complied with a medicine schedule based on the information" is confusing because the claim does not indicate whether the party took the medicine (answer, page 4). If the

party did not comply with the medicine schedule at all the level would be zero, and the examiner has not explained why that would not have been reasonably clear to one of ordinary skill in the art in light of the appellants' specification.

The examiner argues that it is not clear how the determining step in claim 34 is related to the receiving step (answer, page 4). The determining step states that it is based on "the information", and "the information" is the information which the claim states is received in the receiving step.

The examiner does not provide an argument as to why claim 51 is considered to be indefinite.

Thus, the examiner has not carried the burden of establishing a *prima facie* case of indefiniteness of the appellants' claimed invention, and we do not sustain these rejections.

Rejection under 35 U.S.C. § 101

The examiner argues that claims 3-14, 34, 35 and 39-51 do not comply with 35 U.S.C. § 101 because they do not recite a limitation in the technological arts (answer, page 5). As set forth in the precedential board decision *Ex parte Lundgren*, 76 USPQ2d 1385, 1388 (Bd. Pat. App. & Int. 2005), "there is currently no judicially recognized separate 'technological arts'

test to determine patent eligible subject matter under § 101." Accordingly, we do not sustain the examiner's rejection under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103

Each of the appellants' independent claims requires that a first medicine container is capable of communicating with a second medicine container. For this claim requirement the examiner relies only upon the combination of Reber and Andrews (answer, page 11).

Reber discloses two-way communication, which preferably is wireless, between a medical communication apparatus (20) and at least one medicine container (26) (col. 2, line 66 - col. 3, line 3; col. 3, lines 36-39; col. 6, lines 22-23; col. 8, lines 55-62; figures 1 and 2).

Andrews discloses providing security for an electronic device such as a portable computer by wirelessly determining whether the electronic device is within a selected proximity to a remote unit that preferably is worn by the electronic device's owner (col. 1, lines 49-64; col. 2, lines 50-51; col. 2, line 61 - col. 3, line 6).

The examiner argues:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

Reber et al. to include determining whether the first container wirelessly communicates with the second container, as disclosed in Andrews, because it would advantageously enhance the security of the system by indicating that a security violation has occurred if the second container is not within the selected proximity of the first container (See: Andrews; column 1, lines 55-58);^[3] and increase accuracy of determining compliance of the patients with the prescribed schedule of taking medicine. [answer, pages 11 and 14]

* * *

In response to the applicant's argument that the prior art does not teach determining whether a first container ... was positioned so as to wirelessly communicate with a second container ..., it is noted that Reber et al. (hereinafter Reber) teaches a system and method for medical communication apparatus, comprising: receiving the signal from a device that monitors whether the first container and the second container are positioned so as to wirelessly communicate (C.2, L. 66-C. 3, L. 8; C. 6, L. 23-35). Each container for storing medicine, disclosed in Reber, is equipped with a communication circuitry, and is configured to send and receive a "signal". Reber does not specifically teach that said containers wirelessly communicate with each other.

Andrews was applied to show wireless communication between two portable security devices. Furthermore, Andrews discloses the step of determining whether or not the second portable security device is within a selected proximity of the first portable security device (C. 1, C. [sic] 52-61). [answer, pages 25-26]

* * *

In this case, both Reber and Andrews relate to [the] field of wireless communication of data between portable devices. The security feature disclosed in Andrews, would benefit a communication system dealing with health-related issues, disclosed in Reber, by indicating that a security violation has occurred if the second container is not within the selected proximity of the first container (See: Andrews; C. 1, L. 55-58). [answer, page 26]

³ That portion of Andrews states: "In response to a detection that the second electronic device is not within the selected proximity of the first electronic device, a signal is generated indicating that a security violation has occurred."

The examiner has not established that the applied references disclose that theft of medicine containers is a problem, let alone a problem where one medicine container, but not another, is stolen such that the two medicine containers become separated from each other. Nor has the examiner established that Andrews' disclosure of wireless communication between a remote unit and an electronic device to detect theft of the electronic device would have fairly suggested, to one of ordinary skill in the art, communication between two medicine containers. Thus, the record indicates that the motivation relied upon by the examiner for combining the references to provide security comes from the appellants' disclosure rather than coming from the applied prior art and that, therefore, the examiner used impermissible hindsight in combining the references. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960).

Moreover, the examiner's other reason for combining the references, i.e., to increase accuracy of determining compliance of patients with a prescribed schedule for taking medicine, is disclosed by the appellants, but the examiner has not established

that this reason is disclosed in the applied references or would have been fairly suggested by them to one of ordinary skill in the art. Hence, the record indicates that this reason, too, for combining the references relies upon impermissible hindsight in view of the appellants' disclosure.

As for the examiner's argument that Reber's system would benefit from Andrews' security system, even if that argument is correct, the examiner has not established that one of ordinary skill in the art would have been led by the applied references to combine their teachings for that purpose.

For the above reasons we conclude that the examiner has not established a *prima facie* case of obviousness of the appellants' claimed invention.

DECISION

The rejections of claims 3-14, 34, 35 and 39-51 under 35 U.S.C. § 112, second paragraph, claims 3-14, 34, 35 and 39-51 under 35 U.S.C. § 101, claims 3-14, 26, 27 and 39-42 under 35 U.S.C. § 103 over Reber in view of Andrews, claims 28, 29, 34-38, 43, 44, 46-48 and 51 under 35 U.S.C. § 103 over Reber in view of Andrews and Brown, claims 45 under 35 U.S.C. § 103 over Reber in view of Andrews, Brown and Bro, and claims 49 and 50 under 35 U.S.C. § 103 over Reber in view of Andrews, Brown and Daansen, are reversed.

REVERSED

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